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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,085	11/25/2003	Souichi Okada	1466.1080	4876

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EXAMINER


KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/720,085	Applicant(s) OKADA ET AL.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/25/03 (initial filing of application).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

- 5 1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 1 and 2 are objected to because of the following grounds: claim language is
10 wholly up to the Applicant. However, the language must be understandable by others (or one ordinary skill in the art).

Examiner understands the subject matter disclosed in at least claims 1 and 2. However, expression such as “identification means/level” can be interpreted as that Applicant claims two distinct inventions in that identification means and identification level mean two different things.
15 In general, an application is filed for “single” invention. In claim 2, the phrase “includes a digital signature or other information” is vague and indefinite. It is difficult to contemplate what other information is, and therefore it is unclear what Applicant is claiming. This could be an issue for 35 USC 112 rejection. Moreover, such expression could potentially invite apparently unrelated references since they have “other information”.

20 Applicant is respectfully suggested to review and correct not only cited claims but also other claims having similar expressions.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9, 12, 14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Deo et al. (US 5,721,781, hereinafter “Deo”).

10 Re claims 1, 3, 7, 9, 12, 14, 17, and 18, Deo discloses a personal identification terminal 32 which checks person’s identification by various means such as by smart card alone, or by smart card and a personal identification number (PIN) and other additional security means (see abstract; figure 9, col. 11, lines 1+). ATM machine can certainly interpreted as a server, and the server checks identification and security level information when a transaction is initiated by the
15 user. Since security level is determined by the amount of transaction, the lowest level security can be considered a default level.

Re claim 2, the smart card and the terminal transmit back and forth various information which includes a digital signature (see abstract).

Re claim 4, when the incorrect PIN is entered, the incorrect PIN is an “altered
20 identification information”, resulting in that authentication is failed.

Re claims 5 and 6, when the smart card is authenticated by itself, it is inherent that the smart card and the card terminal communicate using a communication protocol. When PIN is additionally required, it is responding to different level of security requirement.

5. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by LeBourgeois (US 6,026,166, hereinafter "LeBourgeois").

See paragraph 8 for LeBourgeois' disclosure.

5 ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the
15 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
20 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 8, 10, 11, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo et al. (US 5,721,781) in view of LeBourgeois (US 6,026,166).

The teachings of Deo have been discussed above. However, Deo fails to specifically teach or fairly suggest that the personal identification terminal further comprises biometric
25 information.

LeBourgeois discloses a smart card transaction system wherein the level of identity (or authenticity) of the individual is verified depending on the transaction (see abstract; col. 2, lines 33+; col. 2, lines 56+; col. 4, lines 7-27; col. 9, lines 29-57). When a user is initially registered, a digital signature is provided (col. 5, lines 32+), and biometric information such as fingerprints or a retinal scan or photo ID is also collected (col. 6, lines 24+). In determining the identify, level of confidence is used by the financial institution. The level of confidence can be described as a predetermined threshold to determine positive or negative authentication of the individual (col. 12, lines 3+; also see claim 2). The certification can have expiration time limiting the use of the certification.

In view of LeBourgeois' teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate well-known biometric information to the teachings of Deo in order to further reduce fraudulent use of the card and avoid the loss caused by identity theft. PIN provides a certain amount of security, however, PIN can be stolen by an observant individual or could be inadvertently given away the user. Accordingly, there have been numerous attempts to close this loophole and therefore protect the genuine users. For example, smart card comprising a fingerprint verification is well known and already used in the industry. Therefore, incorporating biometric features to Deo would be well within one ordinary skill in the art.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Khello (US 5,724,423); Wakins (US 5,719,560); Lewis (US 6,213,391); Holloway (US 5,604,802); Berson et al. (US 5,496,506); Piosenka et al. (US 4,993,068); Chen et al. (US

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5,694,471); Pare et al.(US 6,662,166); Shin (US 6,655,585) disclose personal identification system comprising smart cards. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
March 26, 2005